Remarks

Claims 20-26 and 31-36 are presently pending in the above-identified application. Claims 31 and 36 stand withdrawn from consideration as drawn to a non-elected invention. Claims 20-26 and 35 are indicated to be allowable over the art. Claims 32 and 33 are presently rejected. Claim 32 has been amended herein to incorporate the elements of generic base claim 31, from which it previously depended. The amendment, which does not affect the scope of claim 32, is thus supported by claim 31 as originally filed and does not add new matter. Entry of the amendment is respectfully requested. Following entry of the amendment, claims 20-26 and 32-35 will be pending and under examination.

Regarding 35 U.S.C. § 112, Second Paragraph

The rejection of claims 32 and 33 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention, respectfully is traversed. Applicants submit that claims 32 and 33 are clear and definite in view of the specification for the reasons which follow.

A seminal case on the construction of the second paragraph of § 112 is *In re Borkowski*, 422 F.2d 904, 164 U.S.P.Q. 642 (C.C.P.A. 1970), where the CCPA observed:

> The first sentence of the second paragraph of § 112 is essentially a requirement for precision and definiteness of claim language. If the scope of subject matter embraced by a claim is clear, and if the applicant has not otherwise indicated that he intends that claim to be of a different scope, then the claim does particularly point out and distinctly claim the subject matter which the applicant regards as his invention.

Id. at 909, 164 U.S.P.Q. at 645-46 (footnote omitted).

The Federal Circuit has since had the opportunity to decide a number of § 112, second paragraph issues. It is clear from these decisions that definiteness of claim language must be analyzed, not in a vacuum, but in light of (1) the content of the particular application disclosure, (2) the teachings of the prior art, and (3) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. *See, e.g., In re Marosi*, 710 F.2d 799, 218 U.S.P.Q. 289 (Fed. Cir. 1983); *Rosemount, Inc. v. Beckman Instruments, Inc.*, 727 F.2d 1540, 221 U.S.P.Q. 1 (Fed. Cir. 1984); *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983); and *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 53 U.S.P.Q.2d 1225 (Fed. Cir. 1999) (district court failed to consider the knowledge of one skilled in the art when interpreting the patent disclosure).

> The primary purpose of the definiteness requirement is to ensure that the claims are written in such a way that they give notice to the public of the extent of the legal protection afforded by the patent, so that interested members of the public, e.g., competitors of the patent owner, can determine whether or not they infringe. That determination requires a construction of the claims according to the familiar canons of claim construction.

All Dental Prodx, LLC v. Advantage Dental Prods., 309 F.3d 774, 779-80, 64 USPQ2d 1945, 1949 (Fed. Cir. 2002) (citations omitted).

Claim 32 has been amended herein to incorporate the elements of withdrawn generic base claim 31, from which it depended prior to the present amendment. As a result of the amendment, claim 32 now recites a conjugate, encompassing a peptide that selectively homes to ischemic tissue and that is linked to a moiety and that further includes an amino acid sequence selected from the group consisting of GGGVFWQ (SEQ ID NO: 2); HGRVRPH (SEQ ID NO: 3); VVLVTSS (SEQ ID NO: 4); CLHRGNSC (SEQ ID NO: 9); and CRSWNKADNRSC (SEQ

ID NO: 10), or a functionally equivalent peptidomimetic thereof. As amended, claim 32 is clear and definite in view of the teachings of the specification, prior art and given the skill of the ordinary artisan at the time of the invention. Consequently, the present rejection has been rendered moot.

In view of the above remarks and amendment, Applicants request removal of the rejection of claims 32 and 33 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

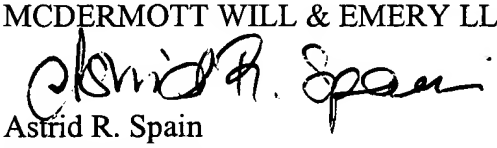
Conclusion

In light of the Amendment and Remarks herein, Applicants submit that the claims are now in condition for allowance and respectfully request a notice to this effect. The Examiner is invited to contact the undersigned attorney with any questions related to this application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 502624 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT WILL & EMERY LLP



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